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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,112	07/02/2003	Jacob Fraden		3389

7590 05/24/2005
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EXAMINER

VERBITSKY, GAIL KAPLAN

ART UNIT PAPER NUMBER

2859

DATE MAILED: 05/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/612,112

Applicant(s)

FRADEN, JACOB

Examiner

Gail Verbitsky

Art Unit

2859

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: attachment #2.

DETAILED ACTION

Claim Objections

1. Claim 1 is objected to because of the following informalities: Perhaps applicant should replace "the outer surface" in line 2 with --an outer surface--and replace "which is" in line 2 with --, the outer surface--. Is this a proper interpretation of the invention? Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2, 8 are finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "thin" in claims 2, 8 is a relative term which renders the claim indefinite. The term "thin" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 1 is finally rejected under 35 U.S.C. 102(b) as being anticipated by Harada (U.S. 5458121).

Harada discloses a probe to be inserted into a body orifice, the probe comprising an inner surface and an outer surface, a plurality of ridges 36 encircling/ separating a plurality of cavities/ circumferential indentation, as shown in Fig. 3.

6. Claims 1-2, 4-5, 7-8 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Fukura et al. (U.S. 6109782) [hereinafter Fukura].

Fukura discloses in Fig. 2 a medical probe device to be inserted in a body cavity/ orifice, the device comprising an inner surface, an outer surface 32 having 2 (plurality of randomly distributed) circumferential indentations / cavities, as shown at 34 and at 30 (encircling the probe body), the indentations/ cavities are encircled by ridges A, B, C, also encircling the probe body; a heat insulating space 38 formed by the indentations is filled out/ covered with a heat insulation material (layer), inherently, having a low thermal conductivity. The skin/ probe 20 is made of a relatively thin synthetic resin (low thermal conductivity material) and, being a part of the probe, is permanently attached to the outer surface of the probe and thus, to the ridges of the outer surface of the probe. (The numerals A-C have been added by the examiner, see attachment # 2 to the Office action)

The method steps will be met during the normal method of insulating the probe as stated above.

Claim Rejections - 35 USC § 103

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7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 6 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Fukura in view of Jang (U.S. 5645350).

Fukura discloses the device as stated above in paragraph 6.

Fukura does not explicitly teach a probe cover, as stated in claim 6.

Jang discloses in Fig. 3 a device in the field of applicant's endeavor comprising a probe cover 2 is made of a polyethylene (polymer) that envelops an outer surface 4 and a thin skin 150.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add a probe cover, as taught by Jang, to the probe disclosed by Fukura, so as to prevent contamination from patient to patient when the probe is intended for clinical/ hospital use, as opposed to a single patient use at home.

Response to Arguments

9. Applicant's arguments with respect to claims 1-2, 4-8 have been considered but are moot in view of the new ground(s) of rejection necessitated by the present amendment.

With respect to Jang: the arguments are now moot.

With respect to Fukura: Applicant states that the cavities/ indentations on the outer surface of the instant invention serve to minimize heat transfer from the patient to the

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inner structures, while Fukura teaches heat insulating space. This argument is not persuasive because this limitation is not stated in claim 1. It is the claims that define the claimed invention, and it is claims, not specification that are anticipated or unpatentable. Constant v. Advanced Micro-Devices, Inc., 7 USPQ2d 1064. On the contrary, Applicant states that the indentations are formed for thermal insulation, therefore, as taught by Fukura.

Applicant states that, in order to differentiate between the instant invention and Fukura, applicant introduces the terms "thin" in claims 2 and 8. A) Please note, that, in the rejection on the merits, the Examiner considers a skin that is thinner than the probe body as a thin skin, B) Also, please refer to paragraph 2.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited in the PTO-892 and not mentioned above disclose related devices and methods.

Uhler (U.S. 5662685) discloses a probe having a plurality of cavities/ indentations randomly distributed around the outer surface of the probe along its longitudinal axis.

Any inquiry concerning this communication should be directed to the Examiner Verbitsky who can be reached at (571) 272-2253 Monday through Friday 8:00 to 4:00 ET.

GKV

Gail Verbitsky

Primary Patent Examiner, TC 2800



May 20, 2005

106/2112

U.S. Patent

Aug. 29, 2000

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6,109,782

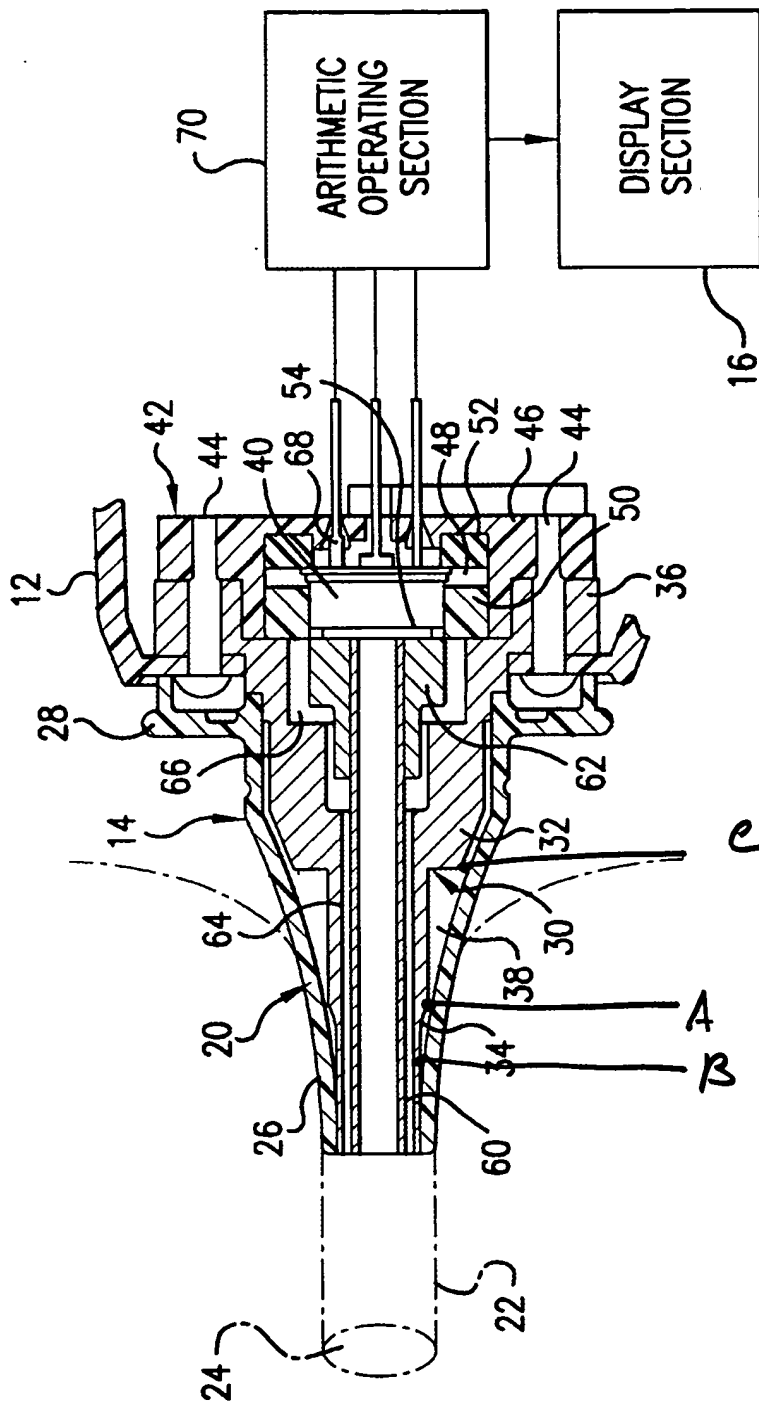


FIG. 2

attachment # 2
(05/20/05)